

REMARKS

Claims 1-10 are pending in the above-identified application. Claims 1, 2, 9 and 10 were rejected. Claims 3-8 were objected to. With this Amendment, claims 1-10 were amended. Accordingly, claims 1-10 are at issue in the above-identified application.

Objection To Specification

The specification was objected to because of informalities. The specification has been amended as requested by the Examiner to overcome this objection. Thus, withdrawal of this objection is respectfully submitted.

Objection To Claims

Claims 3-8 were objected to as being dependent upon a rejected base claim, but were found to be allowable if rewritten in independent form including all of the limitations of the based claim and any intervening claims. Claim 3 has been re-written in independent form, and claims 4-8 each depend either directly or indirectly from claim 3. Thus, withdrawal of this objection is respectfully submitted.

35 U.S.C. § 102 Anticipation Rejection of Claims

Claims 1, 2, 9 and 10 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Dawes* (U.S. Patent No. 4,967,340). Applicant respectfully traverses this rejection. In particular, *Dawes* does not disclose (1) that common processing operations which can be performed by the same set of processing modules be identified or (2) that processing operations which are not common to the processing circuits in the processing circuit design be identified and treated

separately. The Examiner asserts that it is inherent that these steps “should” occur. However this is not the proper standard for inherency. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *See in re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

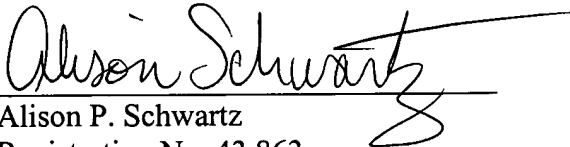
Moreover, the Examiner has not provided sufficient evidence or rationale to meet the required burden of showing inherency. “In relying upon the theory of inherency, the examiner **must** provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (underlined emphasis in original; bold emphasis added).

In view of the foregoing, Applicant submits that the application is in condition for allowance. Notice to that effect is requested.

Respectfully submitted,

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